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EXAMINER
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CHEMPAKASERIL, ANN J

ART UNIT	PAPER NUMBER
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2166

NOTIFICATION DATE	DELIVERY MODE
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03/18/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

krvuspto@ipmatters.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/539,644	<b>Applicant(s)</b> HANNSMANN ET AL.	
	<b>Examiner</b> ANN J. CHEMPAKASERIL	<b>Art Unit</b> 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,16,17,39,40,45 and 46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,16,17,39,40,45 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-2, 16-17, 39-40, and 45-46 are pending

### ***Response to Arguments***

2. Applicant's arguments filed 11/25/2008 have been fully considered but they are not persuasive for the following reasons.

Applicant argues that the specification specifically discloses that as part of synchronization, the client can renew the license and provide for payment after expiration of the original license. Aburri does not disclose how synchronization occurs with respect to updated available content usage at the client.

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification. See MPEP 2111 [R-1]

#### **Interpretation of Claims-Broadest Reasonable Interpretation**

During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).

In response to Applicants argument that the specification specifically discloses that as part of synchronization, the client can renew the license and provide for payment after expiration of the original license, examiner disagrees. The specification says "When the client computer 108 is re-connected to the network license a synchronization

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of entries which have been made in local license database 308 is performed by means of synchronization module 307 and renewal module 306 is started to renew the license and provide payment for the amount of usage of the content data after expiration of the original license.” [0042] Nowhere in the specification does it say that as part of synchronization, the client can renew the license and provide for payment after expiration of the original license. Applicant has equated. Furthermore, applicant has equated “that as part of synchronization, the client can renew the license and provide for payment after expiration of the original license” with determine that the updated license status indicates that the license has expired. Applicants' disclosed “that as part of synchronization, the client can renew the license and provide for payment after expiration of the original license” can be implemented once it is “determined that the updated license status indicates that the license has expired” as claimed. They cannot be the same as the applicant has implied.

In response to Applicants argument that Aburri does not disclose how synchronization occurs with respect to updated available content usage at the client, examiner disagrees. Aburri discloses licenses 16 presently or formerly in the license store 38. Such state information is created by the DRM system 32 and stored in the state store 40 as necessary. For example, if a particular license 16 only allows a predetermined number of renderings of a piece of corresponding digital content 12, the state store 40 maintains state information on how many renderings have in fact taken place in connection with such license 16 [Col 17, lines 55-69] That is, each copy/replacement license utilizes a relatively short-term expiration date instead of the

original expiration date so that long-term continued use of a copy/replacement license requires periodic contact with the license synchronization server in order to update the expiration date (hereinafter "expiry") at step 2740. [Col 58, lines 35-50]

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 states "synchronizing with local license related data on the client indicating an updated license status indicating the updated available content usage updated based on an amount of client usage of the content data..." The statement is unclear as to whether the available content usage is updated when license is updated as well as on an amount of client usage. Clarification is required.

Claim 1 states "the client usage that results in the updating of the client usage in the local license related data occurs at the client..." It is unclear to the examiner what is meant by the client usage that results in the updating of the client usage.

Claim 39 recites "an amount of usage of the content data at the client after the license status is expired at the client when there is no more available content usage" It is unclear how there is any usage when there is no more available content usage. It is unclear what content is being used when there is a lack of available content.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 16-17, 39-40, and 45-46 rejected under 35 U.S.C. 103(a) as being unpatentable by US Patent Application 2003/0088516 issued to Remer et al. further in view of US Patent 7203966 issued to Aburri et al. (hereinafter Aburri)

As per claims 1, 10, and 28, Remer discloses a method for providing of content data to a client (move logic and data over networks to the end user or point- of service (POS) computer [0033]), comprising:

receiving of a selection of content data from the client (selection of licenses are requested by POS that access data, [0033]);

generating a file comprising license information and a locator for the content data, wherein the license information indicates a license status enabling the client to access the content data (The service agent first verifies that the digital signature of the retrieved POS license is valid (310). If so, the service agent compares the Node ID field of the current POS license with the Node ID of the existing license in the discovery database (330). If the Node IDs are different, then this must be a new POS license that has not yet been collected to the discovery database. The service agent collects a copy

of the new POS license into the Servicing component's discovery database (340).

[0077]);

sending of the file to the client (sending the file with license and id to POS

[0079]);

Remer does not appear to explicitly disclose, the license status indicates available content usage; synchronizing with local license related data on the client indicating an updated license status based on an amount of client usage of the content data, wherein the license status including the available content usage is updated at the client, and wherein the client usage that results in the updating of the client usage in the local license related data occurs at the client following the sending of the file to the client and before synchronizing

However Aburri discloses the claimed the license status indicates available content usage (The license includes: a decryption key (ED) that decrypts the encrypted digital content; a description of the rights (play, copy, etc.) conferred by the license and related conditions (begin date, expiration date, number of plays, etc. [Col 3, lines 5-15]);

synchronizing with local license related data on the client indicating an updated license status based on an amount of client usage of the content data, wherein the license status including the available content usage is updated at the client, and wherein the client usage that results in the updating of the client usage in the local license related data occurs at the client following the sending of the file to the client and before synchronizing (corresponding to licenses 16 presently or formerly in the license store 38. Such state information is created by the DRM system 32 and stored in the

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state store 40 as necessary. For example, if a particular license 16 only allows a predetermined number of renderings of a piece of corresponding digital content 12, the state store 40 maintains state information on how many renderings have in fact taken place in connection with such license 16 [Col 17, lines 55-69] That is, each copy/replacement license utilizes a relatively short-term expiration date instead of the original expiration date so that long-term continued use of a copy/replacement license requires periodic contact with the license synchronization server in order to update the expiration date (hereinafter "expiry") at step 2740. [Col 58, lines 35-50])

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms. [Col 3, lines 35-50])

As per claim 2, Remer discloses in response to receiving the selection of the content data from the client, requesting of license conditions information from a license server (license conditions can be retrieved from servicing agent for the POS [0031]) ;

sending of information indicative of one or more license offers to the client (The current POS license, whether it be an install, trial, or previously purchased license, is collected by the external license servicing agent to a discovery database that resides on the service management console [0035]);



and receiving an acceptance from the client (an electronic commerce site that will issue purchased licenses for the software services installed on the POS computers (240). By purchasing, the client accepts the license offers.)

As per claim 16, Remer discloses the generated file comprises an XML file having a defined DTD format (The exchange of licenses may be accomplished in a number of ways. In one example implementation of the method, the exchange is accomplished by formatting an exchange license file that is in well-formed, non-validated XML described by the following DTD [0087]).

As per claim 17, Aburri discloses receiving a request to renew the license from the client and make payment for the renewal in response to the client determining that the updated license status indicates that the license has expired (A purpose of such contact is to synchronize the server's license information with the user's device's license information. For example, when user next connects to synchronization server 1402 from a computing device, e.g. 1302a, any new licenses now contained in the license store 1524 on license synchronization server 1402 will be downloaded to device 1302a and any licenses contained in license store 1510a on device 1302a not in license synchronization server 1402 license store 1524 will be uploaded to server 1402. License synchronization server 1402 may send device 1302a copy/replacement license for any licenses that device 1302a has newly uploaded to the license synchronization server. Copy/replacement licenses are stored in license store 1510a on computing device 1302a [Col 62, lines 40-55])

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms... [Col 3, lines 35-50])

As per claim 39, Aburri discloses the claimed the updated license status includes an amount of usage of the content data at the client after the license status is expired at client when there is no more available content usage. (copy/replacement license may also expire, however, if a user does not connect and synchronize with the license synchronization server from a device before the expiry date of the copy/replacement license. [Col 63-Col 64])

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms. [Col 3, lines 35-50])

As per claim 40, Aburri discloses during synchronization, determining the amount of usage of the content data at the client after the license status is expired at client (copy/replacement license may also expire, however, if a user does not connect and synchronize with the license synchronization server from a device before the expiry date of the copy/replacement license. [Col 63-Col 64]);

Receiving payment for the amount of usage of the content data after the license status is expired, wherein the synchronizing with the local license related data comprises renewing the local license related data to allowed continued use of the content data in response to receiving the payment for the amount of usage (copy/replacement license may also expire, however, if a user does not connect and synchronize with the license synchronization server from a device before the expiry date of the copy/replacement license. [Col 63-Col 64])

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms. [Col 3, lines 35-50])

licenses with new licenses using the discovery database. [0023])

As per claim 45, Aburri discloses the available content usage indicates a fixed number of allowed play, wherein the license status is expired after the content is rendered the fixed number of allowed playbacks (The license includes: a decryption key (ED) that decrypts the encrypted digital content; a description of the rights (play, copy, etc.) conferred by the license and related conditions (begin date, expiration date, number of plays, etc. [Col 3, lines 5-15])

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms. [Col 3, lines 35-50])

As per claim 46, Aburri discloses the available content usage indicates duration of the content playback (A copy/replacement license may expire because the end of the time period for which an original license pertains has been reached [Col 63, lines 35-40]

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms. [Col 3, lines 35-50])

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Contact Information**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann J. Chempakaseril whose telephone number is 571-272-9767. The examiner can normally be reached on Monday through Thursday, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ann J Chempakaseril/  
Examiner, Art Unit 2166  
March 11, 2009

/Khanh B. Pham/  
Primary Examiner, Art Unit 2166